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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/515,363	02/29/2000	Paul B. Fisher	A34614/070050.1690	1657

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05/20/2003

Lisa B. Kole
BAKER & BOTTS
30 Rockefeller Plaza
New York, NY 10112

EXAMINER

QIAN, CELINE X

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 05/20/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/515,363

Applicant(s)

FISHER ET AL.

Examiner

Celine X Qian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-30 is/are pending in the application.
- 4a) Of the above claim(s) 12-30 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 2 is/are allowed.
- 6) ☒ Claim(s) 4-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1, 2 and 4-30 are pending in the application. Claims 12-30 are withdrawn from consideration for being directed to non-elected subject matter. Claims 1, 2 and 4-11 are currently under examination.

This Office Action is in response to the Amendment filed on 8/27/02.

Response to Amendment

The objection to the drawing has been withdrawn in light of Applicants' amendment.

The objection to the specification has been withdrawn in light of Applicants' amendment.

The submission of corrected CRF and paper copy of the sequence listing is acknowledged. The application is now in sequence compliance.

The rejection of claims 1-11 under 35 U.S.C. 101/112 1st paragraph (enablement) has been withdrawn in light of Applicants' amendment of the claims.

The rejection of claims 2-11 under 35 U.S.C. 112 1st paragraph (written description) has been withdrawn in light of Applicants' amendment of the claims.

The rejection of claims 2, 5-11 under 35 U.S.C. 112 2nd paragraph has been withdrawn in light of Applicants' amendment of the claims.

Claim 4 is rejected under 35 U.S.C. 102 (a) for reasons discussed below.

Claims 5-11 are rejected under 35 U.S.C. 103 (a) for reasons discussed below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 4 is rejected under 35 U.S.C. 102(a) as being anticipated by A74554 (10/15/1999) or A77533 (10/19/1999).

Claim 4 is drawn to an isolated nucleic acid sequence that hybridizes to SEQ ID NO: 1.

A74554 or A77533 shares 250 base pair homology with SEQ ID NO: 1. A74554 or A77533 can hybridize to the nucleic acid sequence of SEQ ID NO: 1. Therefore, A74554 or A77533 discloses the instantly disclosed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over A74554 or A77533.

It would have been obvious to one of ordinary skill in the art to make a vector comprising the nucleic acid A74554 or A77533, a host cell comprising said vector, wherein the host cell can be a mammalian cell such as melanocyte or immortalized cell. The ordinary skill in the art would have been motivated to do so to express the polypeptide encoded by A74553 or A77533. At the time of invention, the level of skill in the molecular cloning is high. Inserting a nucleic acid sequence into a vector and introducing the vector into a host cell is routine experimentation. Absent evidence to the contrary, one of ordinary skill in the art would have reasonable expectation of success to make a vector comprising A74554 or A77553 and a host cell

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comprising said vector. Therefore, the invention would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made.


Claims 1 and 2 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celine X Qian whose telephone number is 703-306-0283. The examiner can normally be reached on 9:00-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel Ph.D. can be reached on 703-305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Celine Qian, Ph.D.
May 19, 2003


REMY YUCEL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600